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Oussama Zbib

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AT&T Legal Department - TKHR

Attn: Patent Docketing

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EXAMINER

GARG, YOGESH C

ART UNIT

PAPER NUMBER

3625

MAIL DATE

DELIVERY MODE

03/20/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/068,210	Applicant(s) ZBIB, OUSSAMA	
	Examiner Yogesh C. Garg	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21,22,24,26-29,31,33,35-37,39-42 and 44-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21,22,24,26-29,31,33,35-37,39-42 and 44-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/6/2009 has been entered.

Claims 21, 28, 33, 35, 36, and 39 are currently amended, claim 34 is currently canceled and new claim 47 is newly added. Claims 21-22, 24, 26-29, 31, 33, 35-37, 39-42, 44-47 are pending for examination.

Response to Arguments

2. Applicant's arguments filed 1/6/2009 have been fully considered but they are not persuasive. The examiner has considered the applicant's response diligently and fully. On reviewing the Minte reference in detail the examiner finds that its teachings, "... (see paragraphs 32 and 19 of Minte) do render obvious the newly added limitation in the independent claims. The newly added limitation recites, "*.....Logic in the advertisement content server configured to maintain a logic for each record retrieval event for each record, wherein the data associated with the Logic is made available to the broadcast media outlet that broadcast the advertisement to determine popularity of the broadcast media outlet.* ". The structural ingredient of this limitation is only "*Logic in the advertisement content server configured to maintain a logic for each record retrieval event for each record* ", which when broadly interpreted means that a

program in the server stores and compiles the hits or transactions made in relation to a particular advertisement by a consumer. The rest of the limitation, “*wherein the data associated with the Logic is made available to the broadcast media outlet that broadcast the advertisement to determine popularity of the broadcast media outlet*”, is the intended use as a result of the stored data relating to hits or transactions made in relation to a particular advertisement by a consumer and this intended use is not performed by the recited/claimed advertisement server but by any external source. Paragraph 32 of Minte reads as follows:

“...the Bug is consistent throughout the particular medium it appears in so that it becomes easily identifiable and memorable. Depending on the subscribing-advertiser's needs, the Bug may also include context-information that identifies the context of the first advertisement. In this context-sensitive embodiment, slightly modified Bugs may be used for a particular commercial, depending on the context in which the commercial is shown. Context-information may include, for example, the television show, the time during which, or the geographic location where, the commercial is shown. The Bug points to a specific Web-server and a file on that server, and each Bug includes the context-information, which may take the form of a different file on the specified server. Because the Bug is different for each advertisement (and may be different between the same advertisement shown in different contexts), the consumer's behavior upon accessing the specific Web-page indicates to a degree the effectiveness of the first advertisement in the first medium in each particular context. Typical statistical

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measurements of effectiveness include hits, page-views, click-through, time spent on the page/file/server, and transactions made/recorded. The statistical data compiled provides a means for evaluating the effectiveness of advertisements made in non-Web media. “

The underlined excerpt above teaches recording/storing/compiling the hits/transactions related to the advertisements asked for by a consumer and this compiled/stored/recorded data is provided to any third party which could be any party including advertisers/broadcast media outlet to evaluate the effectiveness of their advertisements.

In view of the foregoing, rejection of claims 21-22, 24, 26-29, 31, 33, 35-37, 39-42, 44-46 as being unpatentable in view of Minte/Speicher/Eckel is sustainable. Further, the above disclosure of Minte also renders obvious the limitations of new claim 47, dependent on claim 21, that is, *“wherein at least a portion of the data associated with the log is provided to the advertiser as a market saturation indicator.”*. Paragraph 32 of Minte, as analyzed above discloses providing/using the compiled/stored/recorded data including hits/transactions related to the advertisements asked for by a consumer is provided to any third party which could be any party including advertisers/broadcast media outlet to evaluate the effectiveness of their advertisements and therefore the provided data can act as a market saturator.

3. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified

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citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other relevant and related passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the other relevant and related passages and figures in the cited references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4.1. Claims 21-22, 24, 27-29, 31, 35-37, 40-42, 44-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minte in view of Speicher (US Patent 6,697,786) and further in view of Eckel, Jr. (US 20070124165 claiming priority to September 24, 1999), hereinafter Eckel.

Regarding claim 21, Minte combined with Speicher teaches a new system for communicating information about an advertisement, comprising:

logic in an advertisement content server configured to receive advertisement information associated with a plurality of advertisers (see Minte, at least paragraph

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0032, 0043, Fig.1, paragraph 0045, Fig.2 which disclose that the advertisement content server in the form of Mall site “40” receives advertisement information associated with a plurality of advertisers and the mall-site 40 would inherently require a logic/program to receive the information from advertiser (s), just as from ‘Joe’s” and store and display the same . **These advertisements include advertisements being broadcast by a media broadcast media outlet);**

(Note: In order to receive and store the advertisements, a computer program will definitely include logic because in a computer program defining the logic of program is often a first step tin developing the program’s source code, see definition of “logic” in “Microsoft Computer Dictionary, Third edition, 1997. Note: The reference of Microsoft Computer Dictionary is cited as a mere evidence to show that a computer application program, that will be used in Minte to receive and store the advertisement information in digitized form will include a logic and defining a logic in developing a program is a first step. Minte further discloses using a computer program/logic in response to receiving a request for search of an advertisement either via “bug” or directly receiving a request for content and then searching for the same and presenting it to the user.)

logic in an advertisement content server configured to store the information as records within defined fields (see Minte, at least paragraph 0044 and Figs.1-4, Reference # “40” and “60” which show the defined fields, such as “Broadcast call letters”, “ Broadcast promotion” and “ Menu of Advertisers”, The Menu of Advertisers includes further defined fields/categories, such as “coupons”, “specials”, “Catering info”);

logic in an advertisement content server configured to receive a search request from the user, (see Minte, at least paragraphs 0032-0033, 0044-0045 which disclose that a user can go directly to the Mall site “40” that is the server and then research [search] the products of interest, see Figs.2-4, that is a user can send a search request for “coupons” and “specials” at “Eat at Joe’s” eatery);

Minte does not explicitly teach that the advertisement server is configured to: provide to user, a search window that includes a plurality of search fields, the plurality of search fields configured to receive user-defined search criteria, the plurality of search fields including a first search field configured to facilitate a search of a predetermined first criteria, the first criteria g about the advertisement, the plurality of search fields including a second search field configured to facilitate a search of a predetermined second criteria, the second criteria being about the user, the plurality of search fields including a key field configured to facilitate a search across the first search field and the second search field; receive from a user at least one search term related to one of the defined fields and in response to perform a search function according to the at least one search term.

Speicher teaches in the field of Personal Ad services searching advertisements by providing to a user a search window/form that includes a plurality of search fields, the plurality of search fields configured to receive user-defined search criteria, the plurality of search fields including a first search field configured to facilitate a search of a predetermined first criteria being about the advertisement, the plurality of search fields including a second search field configured a search of a predetermined second criteria, the second criteria being about the user, the plurality of search fields including a key field configured to facilitate a search across the first search field and the second search field (see fig.16. The searching window/form as depicted in fig.16 includes a plurality of search fields “22003, 2206, 2204, 2205, 2207” enabling the user to enter different attributes which can facilitate a search of predetermined criteria such as one criteria being about the advertisement that relates to the gender of the advertisement , another criteria being about the user to facilitate the search , that is his preferences for a single low age match and a key field related to the gender of the match configured to facilitate the user to search across for a desired advertisement. In view of Speicher, it would be obvious to one of an ordinary skilled in the art, to incorporate and use this feature in Minte because it would enable the user to receive additional information about the advertised products, such as product names/description/price, etc. by using keywords and search term related to the advertised product based upon a user’s preference attribute after having accessed the web site of the advertised product (see Minte at least paragraph 0034). As regards the newly added limitation that the

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advertisement being broadcast by a broadcast media outlet paragraph 32 teaches this by disclosing that the context information , for example, could be a television show.

Minte/Speicher as applied to claim 21 above does not teach that the received search request includes at least one first term associated with the first criteria and at least one second term associated with the second criteria and comparing the first term with the second term to provide the user with a limited set of media outlets to determine a source of advertisement. However, Eckel teachings (see at least Abstract and paragraphs 11-16) are reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Eckel like the applicant provides two terms such as “INEED” [the first term comprising other similar terms such as IWANTA or FINDME and so on, see paragraph 15] and “ AHOTELROOM” [the second term comprising other similar terms such as “ADOCTORr” or “AGIFT” and so on, see paragraph 12). The first terms are associated with criteria of the requestor’s expression of a requirement and the second term is associated with other criteria detailing the subject of his requirement. These two terms are considered and compared with each other by a server on receipt of the request from the user to provide the user with limited sources for the desired subject which can also include an advertisement as recited in the applicant’s claim. In view of Eckel, it would be obvious to and within the objective reach of an ordinary skilled in the art to modify Minte/Speicher as applied to claim 21 above to incorporate the features of receiving a search request including at least one first term associated with the first

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criteria and at least one second term associated with the second criteria and comparing the first term with the second term to provide the user with a limited set of media outlets to determine a source of advertisement because , as demonstrated in Eckel, it will allow a consumer to use a simple and intuitive approach to desired goods/services/items/articles or advertisements (see Eckel at least paragraph 11).

Minte teaches that a logic in an advertisement content server is configured to transmit at least a portion of the information to the user resulting from the search function (see at least paragraph 0046 & Fig.3 wherein the consumer is conveyed the information of the advertisement he is looking for, such as “Joe’s” eatery).

Minte teaches a logic in the advertisement content server configured to maintain a logic for each record retrieval event for each record, wherein the data associated with the Logic is made available to the broadcast media outlet that broadcast the advertisement to determine popularity of the broadcast media outlet (see at least paragraph 0032). The structural ingredient of this limitation is only the portion *“Logic in the advertisement content server configured to maintain a logic for each record retrieval event for each record”*, which when broadly interpreted means that a program in the server stores and compiles the hits or transactions made in relation to a particular advertisement by a consumer. The rest of the limitation, *“wherein the data associated with the Logic is made available to the broadcast media outlet that broadcast the advertisement to determine popularity of the broadcast media outlet”*, is the intended use as a result of the stored data relating to hits or transactions made in relation to a particular advertisement by a consumer and this intended use is not performed by the recited/claimed advertisement server but by any external source. The underlined excerpt of paragraph 32, see above, teaches

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recording/storing/compiling the hits/transactions related to the advertisements asked for by a consumer and this compiled/stored/recorded data is provided to any third party which could be any party including advertisers/broadcast media outlet to evaluate the effectiveness of their advertisements. In order to store/compile/record the hits/transactions related to consumer's request for advertisement at a web site/server a program/logic would be inherently required.

Regarding claim 22, Minte discloses that the system of claim 21, wherein the system is configured to provide at least one advertiser access to the information via the Internet/ a remote database client (see at least paragraph 0029 which discloses that an advertiser's information can be accessed via web-link which corresponds to the use of Internet or remote database client).

Regarding claim 24, Minte discloses that in the system of claim 21, at least one field includes broadcaster identification information (see Fig.2, " WXYZ TV or WQRS Radio") and advertiser identification information (see at least Fig.2, " Eat at Joe's").

Regarding claim 27, Minte discloses all the limitations of claim 21, as analyzed above. Minte further discloses, that the advertisement information could include unpublished advertisements that are available through the advertisement content server (see at least Figs. 2 and 3 and paragraphs 0043 and 0046 which include

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information on coupons, specials, as part of the supplemental/extended information of an advertisement available only through the content server, that is Mall site "40").

Regarding claims 28-29, 31, 35-37, and 40, their limitations are closely parallel to the limitations of claims 21-24 and 27 and are therefore analyzed and rejected on the same basis.

Regarding claims 41-42, its limitation describes the type of criteria and, as analyzed above in claim 21, the plurality of search fields shown in Fig. 16 (Speicher) are configured to accept any search criteria, whether it is related to a gender or age or user's preferences or some keywords, etc and these search fields can also accept data relating to an address of the user or his preferences, such as a radio station or a television station which the user listens to or watches to. It would be obvious to one of an ordinary skilled in the art to configure entering attributes in the given plurality of fields in the Advertisement search form shown in fig.16 such that they are related to the search of an advertisement and the user/user's preferences to help in searching the right advertisement based upon the user's entry of attributes. The information about user's preferences relating to low age, single, etc. in Speicher or relating to user's other preferences such as his likings for radio station or TV would help in searching the right mate for the user in Minte or for searching the right product/gift related to the user's preferences for radio station or TV station. The necessary structure and functionality are taught in the combined prior art of Minte and Speicher which can enable the limitations

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recited in claims 41-42 and therefore claims 41-42 are obvious in view of Minte/Speicher.

Regarding claims 44-45, their limitations are closely parallel to the limitations of claims 41-42 and are therefore analyzed and rejected on the same basis.

Regarding claim 46, Minte/Speicher/Eckel renders the limitations of claim 21 obvious. In the limitations recited in claim 46, "The system of claim 21, further comprising, logic configured to provide to the advertiser, information to identify at least one preferable time slot, media outlet, and market saturation" the limitation which further narrows down the limitations of claim 21 is the logic function to provide information to an advertiser. The rest of the limitation ".to identify at least one preferable time slot, media outlet, and market saturation" is intended use of the information provided to the advertiser and this is not the part of the claimed system. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case, the system disclosed in Minte teaches providing information including statistical data resulting from the consumer's requests for advertisements to advertisers and the same can be used by the advertisers for marketing activities identifying preferable time slot, media outlet, and market saturation

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from the received data. In view of the foregoing, the combined teachings of Minte/Speicher/Eckel read upon the limitations of claim 46.

Regarding claim 47, the limitation , “*wherein at least a portion of the data associated with the log is provided to the advertiser as a market saturation indicator.* “, is either disclosed or obvious in view of the disclosure in paragraph 32 of Minte. Paragraph 32 of Minte, as analyzed above, discloses providing/using the compiled/stored/recorded data including hits/transactions related to the advertisements asked for by a consumer is provided to any third party which could be any party including advertisers/broadcast media outlet to evaluate the effectiveness of their advertisements and therefore the provided data can act as a market saturator.

4.2. Claims 26, 33 and 39 are rejected under 35 U.S.C. 103(a) as being obvious over Minte/Speicher/Eckel and further in view of Stein (US Patent 5,826, 241).

Regarding claim 26, Minte in view of Speicher in view of Eckel discloses all the limitations of claim 21, as analyzed above, but does not disclose that the system is configured to charge a fee for accessing the information. However, Stein teaches this limitation (see at least Fig.1, 6J, col.3, lines 17-37, col.10, line 62-col.11, line 13 discloses that the payment system “10” charges a service fee “148” for providing services to the seller to sell information products in digitized form.). In view of Stein, it would have been obvious to one of an ordinary skilled in the art at the time of the

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invention to have modified Minte in view of Speicher as applied to claim 21 by incorporating the feature of charging a fee for accessing the information because it will help to meet the expenses of establishing the Mall site 40 and also it would be a medium to earn income for the company which owns the Mall site "40".

Regarding claims 33 and 39, their limitations are closely parallel to the limitations of claim 26 and are therefore analyzed and rejected on the same basis.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex/Hoteling.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Yogesh C Garg/
Primary Examiner, Art Unit 3625